

REMARKS

By this Amendment, claim 38 is canceled. Accordingly, claims 29-37 and 39-45 are pending.

The Office Action rejects claim 38 under 35 USC §112, first paragraph. The rejection is moot because the claim is canceled.

The Office Action rejects claim 32 under 35 USC §112, first paragraph because the specification allegedly does not reasonably provide enablement for selector means based on the assertion that "the applicant only discloses a scanner in the instant specification."

This rejection is respectfully traversed.

Reference is made to page 7 of Applicants' originally filed specification which discusses Fig. 3 and states, in pertinent part, "The list of tokens is sent to a token selector 380, which allows the user to choose which tokens to access. Once one or more tokens are selected, they can be stored in a memory 385 or sent to an interpreter 390" (emphasis added). A scanner is disclosed to read the tokens - see page 6, lines 20-26, and page 7, lines 12 and 13.

The scanner 360 is not disclosed as a selector, as alleged in the Office Action, but as a reader. The rejection misstates Applicants' disclosed invention and, therefore, is based on an invalid premise. Accordingly, the rejection is improper and should be withdrawn.

The Office Action rejects claims 29-38 under 35 USC §102(b) over U.S. Patent 5,905,246 to Fajkowski. This rejection is moot with respect to claim 38 and respectfully traversed with respect to the remaining claims.

The Office Action alleges that col. 3, lines 51-62 of Fajkowski discloses a system for decoding tokens and using tokens encoded in a document "by means of a barcode embedded in a coupon."

However, Applicants define a "token" on page 2 of the specification, lines 10-13, as (1) having two parts, the reference and the access information, and as (2) "a pointer to a document, not a copy of a document." Claims 29-37 recite tokens that point to another document, a feature totally lacking in Fajkowski.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Because claims 29-37 recite a feature not disclosed by Fajkowski, Fajkowski does not anticipate claims 29-37. Accordingly, the rejection should be withdrawn.

The Office Action rejects claims 39-45 under 35 USC §103(a) over U.S. Patent 5,486,686 to Zdybel in view of U.S. Patent 5,331,547 to Laszlo. This rejection is respectfully traversed.

The Office Action tacitly admits that Zdybel does not disclose a token that links one paper document to another paper document. To rectify this shortcoming in Zdybel, the Office Action relies on Laszlo, which is alleged to disclose a token that links a paper document to at least one other paper document, referencing col. 4, lines 31-34, col. 5, lines 66-68 and col. 5, lines 1-4.

It is well settled that a rejection based on 35 USC 103 must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995); In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ

459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. However, the suggestion

to combine need not be express and "may come from the prior art, as filtered through the knowledge of one skilled in the art." *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

The Office Action provides absolutely no motivation to combine the applied references. All that the Office Action does, is to speculate about what would happen if the two references were combined, to wit: "[T]his modification basically expands the range of links for Zdybel's tokens." This not even a broad conclusionary statement concerning motivation to combine the references. It is simply a statement of what might happen if these two references are somehow combined. Moreover, the Office Action is completely silent as to how Zdybel is to be modified in view of Laszlo.

As is well settled, the factual basis of a Section 103 rejection must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he advances. He or she may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Applicants respectfully submit that the only reason for combining these references in whatever manner they have been combined is based solely on improper hindsight reconstruction of Applicants' invention based solely on Applicants' own disclosure.

Accordingly, because the Office Action fails to make out a prima facie case of obviousness of claims 39-45, the rejection is improper and should be withdrawn.

Applicants respectfully submit that claims 29-37 and 39-45 are allowable and that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that there is anything further that would place the application in even better condition for allowance, Applicants invite the Examiner to contact Examiner's undersigned representative at the telephone number listed below.

Respectfully submitted,



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